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67108-048

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mooi Choo Chuah

Serial No.: 09/973,399

Filed: October 9, 2001

Group Art Unit: 2683

Examiner: Nguyen, Joseph D.

Title: SYSTEM AND METHOD FOR SWITCHING BETWEEN BASE STATIONS
IN A WIRELESS COMMUNICATIONS SYSTEM

REQUEST FOR RECONSIDERATION

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is responsive to the Office Action mailed on July 21, 2005. Applicant respectfully requests reconsideration of this application.

Applicant respectfully traverses the rejection under 35 U.S.C. §103 of claims 1, 4-5, 7 and 12-22 based upon the proposed combination of *Iseyama* and *Toskala, et al.* There is no *prima facie* case of obviousness because there is no motivation for making the combination. A combination cannot be made when it is contrary to the teachings of the primary reference. Here, the Examiner proposes to add an identity of a new base station signaled by a mobile station from *Toskala, et al.* to the arrangement of *Iseyama*. This would be directly contrary to the teachings of *Iseyama*. Column 12, lines 23-26 of *Iseyama* teach, "the radio base station (the new radio base

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station) 12 instructs the base station control unit 18 to make it the new radio base station and requests the base station control unit 18 for hand over." Therefore, *Iseyama* teaches that the base station provides the identity information for facilitating the handover. If one were to substitute in the teachings of *Toskala, et al.*, that would be contrary to the teachings of *Iseyama* and the combination cannot be made.

Further, even if the combination could somehow be made, it is not the same as Applicant's claimed invention. Applicant respectfully disagrees with the Examiner's interpretation of the *Iseyama* reference. *Iseyama* does not teach waiting for an indication from the wireless communication system to switch to a new base station and receiving downlink data from said previous base station via a shared downlink data until said indication as the Examiner's suggests in paragraph 6 of the Office Action. Referring to Figure 11 and its description, it is clear that at the points (21) and (3), the mobile station changes to the new carrier frequency. Later in Figure 11 at the step (11) the base station controller initiates the new base station. This does not occur until after the change at (21) and (3). Therefore, there is no waiting in *Iseyama* and no continued reception of downlink data from a previous base station. The frequency changeover in *Iseyama* occurs responsive to communication of the condition report and a decision by the base station control unit 18 regarding what channel is available for that mobile station. There is no waiting as suggested by the Examiner. Additionally, there is no continued reception of downlink data because the carrier that the mobile station used for communicating with the original base station was changed before the new base station was initiated at (11). Therefore, *Iseyama* does not teach what the Examiner contends and even if the combination could be made, the result is not what the Examiner contends and not the same as Applicant's claimed invention. There is no *prima facie* case of obviousness.

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Further, the Examiner is incorrect in asserting that *Iseyama* teaches a step of receiving downlink data from said previous base station until an indication from said previous base station that data for said wireless unit at said previous data [sic, base station] has been sent. The Examiner relies upon Figure 11 and its description for this purpose. There is no such communication or indication from the previous base station to the mobile station in *Iseyama*. The only communication that occurs in Figure 11 at steps 1, 10 and 10' are the condition report and a condition report acknowledgement. There is nothing within *Iseyama* that teaches an indication regarding that data for the wireless unit from the previous base station has been sent. Moreover, the other claims referenced by the Examiner at that point of the Office Action include different limitations that the Examiner does not even address. *Iseyama* does not include any of those limitations.

Applicant respectfully traverses the rejection of claims 3 and 8-9 under 35 U.S.C. §103 as being unpatentable over *Iseyama* modified by *Padovani, et al.* There is no *prima facie* case of obviousness. First of all, the Examiner has already acknowledged that *Iseyama* does not teach the signals indicating an identity of the new base station. Therefore, at a minimum, the Examiner would have to combine *Iseyama, Toskala, et al.* and *Padovani, et al.* in an attempt to establish a *prima facie* case of obviousness. By the Examiner's own admission, the combination of *Iseyama* and *Padovani, et al.* is insufficient to establish a *prima facie* case of obviousness.

Moreover, the combination cannot be made. *Iseyama* does not include any variable data rate usage. There is no discussion whatsoever with *Iseyama* regarding variable data rates. Therefore, there is no use for benefit within the scope of the *Iseyama* reference for incorporating the teachings of *Padovani, et al.* as suggested by the Examiner. *Iseyama* is concerned with identifying an available channel for a mobile station needing handoff. Adding a data rate

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indication does not facilitate that and, therefore, provides no benefits. Without any benefit, there is no motivation for making the combination and no *prima facie* case of obviousness. Applicant's disclosure and claims cannot be used as a source for deciding how to piece together portions of prior art references in an attempt to establish a *prima facie* case of obviousness. Such hindsight reasoning is not permitted under 35 U.S.C. §103.

Applicant respectfully traverse the rejection of claims 10-11 under 35 U.S.C. §103 based upon *Iseyama* in view of *Forssell, et al.* There is no *prima facie* case of obviousness. First of all, the Examiner has already acknowledged that *Iseyama* alone does not teach signals indicating an identify of the new base station. The Examiner relied on *Toskala, et al.* for such a teaching. Therefore, at a minimum, the Examiner would have to attempt to combine *Iseyama, Toskala, et al.* and *Forssell, et al.* The combination of *Iseyama* and *Forssell, et al.* does not establish a *prima facie* of obviousness.

Moreover, the combination cannot be made. There is no motivation for adding an indication regarding data packets being ready to be sent to the new base station, which the Examiner's contends *Forssell, et al.* teach at column 14, lines 39-56, to *Iseyama's* system. As already explained, and as is clear from Figure 11, the mobile station 11 changes radio frequency before the new base station is initiated at (11) in Figure 11. Additionally, the original base station ceases to use the channel that it was previously communicating with the mobile station on at (22), which is also before initiating the new base station at (11). Therefore, an indication of the type described in paragraph 8 of the Office Action has no use in *Iseyama's* arrangement. It would be redundant and useless information because the mobile station has already switched frequencies and the previous base station has already stopped all communications with the mobile station. There is nothing within *Iseyama* that indicates any other type of communication

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would have any benefit, regardless of whether that communication comes from the teachings of *Forsell, et al.* or any other reference. There is no *prima facie* case of obviousness.

All of Applicant's claims are allowable. The proposed combinations cannot be made. Even if it were possible to make any one of them, the result would not be the same as the claimed invention of any of Applicant's claims as described above.

This case is in condition for allowance.

Respectfully submitted,

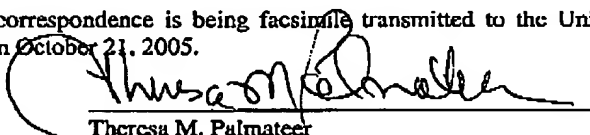


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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, 571-273-8300, on October 21, 2005.


Theresa M. Palmateer

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